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In re Application of
CHIBA et al.
Application No.: 09/807,322
PCT No.: PCT/EP99/07691
Int. Filing Date: 13 October 1999
Priority Date: 26 October 1998
Attorney Docket No.: MO6319/SBU-1
For: METHOD OF PREPARING RIGID
POLYURETHANE FOAM

DECISION ON
PAPERS UNDER 37 CFR 1.42

The is a response to the declaration filed 18 May 2001 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 13 October 1999, applicants filed international application PCT/EP99/07891, which claimed a priority date of 26 October 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 04 May 2000. A proper Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 26 April 2001.

On 11 April 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a preliminary amendment.

On 07 May 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a one-month time limit in which to respond.

On 18 May 2001, applicant filed a declaration and power of attorney executed by Takuya Matsumoto and Keiichi Kitano as inventors and Kazuko Chiba, Kumiko Chiba, and Mamiko Chiba on behalf of deceased inventor Takanori Chiba.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 18 May 2001 was executed by Kazuko Chiba, Kumiko Chiba, and Mamiko Chiba as "heir" to the deceased inventor Takanori Chiba. However, the declaration does not state that Kazuko Chiba, Kumiko Chiba, and Mamiko Chiba are the sole heirs of the deceased inventor. Absent a statement that the signing heirs are the sole heirs of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42.

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the signing heir. The declaration filed on 18 May 2001 provides this information with respect to the signing heir, but not the inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

The submission of the declaration executed by all of the heirs of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR

1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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